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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,317	10/20/2000	Kia Silverbrook	ART85US	8404
24011 .7590 05/19/2004 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER REITZ, KARL	
			ART UNIT 2624	PAPER NUMBER 7

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/693,317

Applicant(s)

SILVERBROOK ET AL.

Examiner

Karl R. Reitz

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: the correct serial numbers for the co-pending applications that have been incorporated by reference on pages 1-5 are required.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 29 (figure 3, although 529 is mention on page 7 line 6 and seems to reference the same part as 29) and 222 (figure 6). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 500 (page 6 line 15). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2624

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsunoshita (6,603,864).
6. In accordance with claim 1, Matsunoshita discloses an apparatus 52 (figure 20) of reading digital data printed on a photograph in invisible ink (col. 16 lines 6-7).
7. Matsunoshita further discloses that the data is encoded data from a camera system (col. 16 lines 15-16, in which it would be inherent to use a camera to input an image either by connecting a digital camera to PC in figure 20, or by scanning a hard copy of a picture in the scanner 52).
8. Matsunoshita further discloses that the apparatus includes a scanner means 57 for scanning in the invisible ink data on the photograph (col. 18 lines 8-9).
9. Matsunoshita further discloses that the apparatus includes means for advancing the print media through the scanner means and means for illuminating the print media with invisible radiation (col. 17 lines 51-65).
10. Matsunoshita further discloses that the apparatus includes means 55 for processing the data output from said scanner means including means for decoding said data; in Matsunoshita's system, the scanner means 57 detects infrared data on the image and the embedding unit 55 processes the data output from the scanner means 57 for decoding and sends it to the personal computer (col. 18 lines 14-18).

11. Matsunoshita further discloses that the apparatus includes ink jet printer means for printing out the image derived from said decoded data on a print media attached to said ink jet means; in Matsunoshita's system, print 51 uses 5 inks to print the images YMCK and IR toner (col. 16 lines 62-65).

12. Matsunoshita's system primarily teaches detecting and printing using IR toner for encoding and decoding bar codes and copyright information, and hence does not disclose expressly the encoding of image data. However, Matsunoshita does disclose that the data encoded could be any other form of data (col. 8 line 25), thus anticipating the encoding of image data as well.

13. In accordance with claim 4, Matsunoshita discloses that the printer 51 embeds the data printed in IR ink into the image printed from the image data (col. 16 lines 4-6 and 8-9).

14. In accordance with claim 3, Matsunoshita discloses using IR ink as the invisible ink (col. 16 line 6).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunoshita in view of Zhang (5,771,245).

Art Unit: 2624

17. In accordance with claims 2 and 5, Matsunoshita does not disclose expressly that the image data is encoded and decoded using the Reed-Solomon process.

18. Zhang discloses using the Reed-Solomon process to encode/decode data (col. 4 lines 18-20).

19. Matsunoshita and Zhang are combinable because they are from the same field of endeavor, namely two-dimensional data encoding and decoding.

20. Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to use the Reed-Solomon process, as taught by Zhang, as the encoding/decoding process in Matsunoshita's system.

21. The motivation for doing so would have been that the Reed-Solomon process is a well-known process in the art to protect encoded data (Zhang: col. 4 lines 18-20).

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other art cited discloses methods of scanning and printing in invisible ink, including IR ink. The art generally discloses using IR ink for the purposes of encoding sound data invisibly over a printed image, and thus further anticipates the use of the same processes to encode image data instead of sound data.

### ***Contact Information***

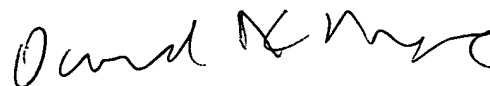
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl R. Reitz whose telephone number is (703) 305-8696. The examiner can normally be reached on Monday-Friday 8:00-4:30.

Art Unit: 2624

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 305-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KRR



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